

PRE-APPEAL BRIEF REQUEST FOR REVIEW

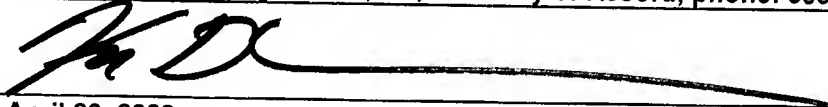
Address to:
Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

In re Application of: **SUWALA ET AL.**
Application Number: **10/790,946**
Confirmation Number: **2173**
Filing Date: **March 2, 2004**
For: **Hierarchical Protection Switching Framework**
Art Unit: **2416**
Examiner Name: **ALIA, Curtis A**
Attorney Docket No.: **36765**

**Applicant requests review of the final rejection in the above-identified application.
No amendments are being filed with this request.**

This request is being filed with a notice of appeal.

The review is request for the reasons stated on the attached FOUR (4) sheets.

Attorney of Record	Kirk D. Williams, Reg. No. 42,229, Attorney of Record, phone: 303-282-0151
Signature	
Date	April 20, 2009

REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

Appellants respectfully submit that the claims are allowable and the prior Office actions are deficient at least the reasons that there is clear error in fact in all of the Office's claim rejections, and the Office clearly fails to establish a *prima facie* case of anticipation nor obviousness for any of the claims, as the prior art of record, alone or in combination, neither teaches nor suggests all the claim limitations.

There are three independent claims pending: claims 1, 11, and 18. Independent claim 1 stands rejected as being anticipated under 35 USC § 102(e) by Finn et al., US Patent 6,728,205; while independent claims 11 and 18 stand rejected as being obvious under 35 USC § 103(a) over Finn et al., US Patent 6,728,205, in view of Lindskog et al., US Patent 6,665,262.

The MPEP and law is clear that for anticipation, the reference *must teach each and every aspect of the claimed invention* either explicitly or impliedly, and the burden is on the Office to present a *prima facie* case of anticipation. MPEP § 706.02 (emphasis added). Inherent means it *must* occur. The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP § 2112 (*emphasis in original*).

First, the anticipatory rejection of claim 1 will be discussed. Claim 1 recites:

Claim 1 (original): An apparatus for protection switching, the apparatus comprising:

a detector; and

a first protector configured to perform protection switching in response to one or more notifications of a condition received from the detector, and to register with the detector to be notified of the condition;

wherein the detector is configured to receive one or more registration requests from the first protector, and to notify the first protector of the condition upon detection of the condition.

Therefore, to anticipate claim 1, Finn et al. must teach, *inter alia*:

1. an apparatus including a detector and first protector; and
2. the first protector configured to register with the detector to be notified of the condition; and the detector configured to receive one or more registration requests from the first protector.

In rejecting claim 1, the Office equates:

- the claimed detector to Finn et al.'s APS Processor 14 of FIG. 1; and
- the claimed first protector to Finn et al.'s Protection Switching Module 18 Processor 14 of FIG. 1.

Final Office action, mailed January 21, 2009, page 3. Therefore, a *prima facie* anticipatory rejection is required to include a teaching of Finn et al. that Protection Switching Module 18 is configured to register with APS Processor 14 to be notified of the condition [in order to perform protection switching in response to such notification of the condition]. In attempting to provide such a teaching, the Office relies on col. 15, lines 29-35 of Finn et al., which are reproduced below:

In this case, APS processor 14 receives information concerning the number of nodes which will be eventually included in the network or subnetwork as well as information concerning the availability or desirability of installing and/or maintaining network links between particular nodes, traffic load and cost information with respect to installation and maintenance of the links and nodes, etc

Appellants respectfully traverse this teaching of Finn et al. for teaching that Protection Switching Module 18 is configured to register with APS Processor 14 to be notified of the condition; and in fact, this teaching is *non sequitur* to the limitation to which the Office applies this teaching. Independent claim 1 requires that the *first protector register with the detector to be notified of the condition*, not that the detector receives network topology information from other nodes.

In attempting to clarify its position in response to Appellants' traversal presented in Amendment B filed October 12, 2008, in the present application, the Office states that it is broadly construing the claim such that "the APS processor receives network topology information from each node in the network so as to accurately create working and protection routing tables.... This act of connecting and exchanging information as being [sic] equivalent to the registration of claims 1, 2-5 and 8-10..." Final Office action at page 2.

In re SUWALA ET AL., Application No. 10/790,946
REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

Again, claim 1 expressly recites the limitation of the *first protector register with the detector to be notified of the condition* not that nodes external to the device provide connectivity information. In its statement of rejection as discussed *supra*, the Office equates:

- the claimed first protector to Finn et al.'s Protection Switching Module 18; and
- the claimed registering by the first protector to be external nodes providing information to APS processor 14.

These underlined elements are not the same as would be required for a proper rejection.

Again, a *prima facie* case based on the equating of Finn et al.'s elements to the claimed elements by the Office requires the Finn et al.'s Protection Switching Module 18 registers for notification with Finn et al.'s APS processor 14. In contrast, the Office admits that it is not the Finn et al.'s Protection Switching Module 18 provides this information, but rather external nodes. As the Office action fails to present a coherent rejection, the Office action fails to present a *prima facie* rejection of independent claim 1.

Additionally, the common definition of an apparatus is a single appliance or device for a particular purpose. Claim 1 recites an apparatus comprising a detector and first protector. Therefore, the claim requires a single device to include these two elements and their recited limitations of their configuration. As discussed, the Office is relying on nodes external to Finn et al.'s Network Node 12a including APS Processor 14 and Protection Switching Module 18. Therefore, the rejection presented in the Office action fails to teach an apparatus configured as claimed.

For at least these reasons, the rejection of independent claim 1 includes clear error. Additionally, as the Office action relies on Finn et al. in rejecting all pending claims for at least one or more of the deficiencies / clear error as discussed *supra*, the Office action includes clear error in the rejection of each and every pending claim.

For at least these reasons, Appellants respectfully request the rejections of all pending claims be withdrawn. Moreover, as the prior art of record, alone or in combination, neither

In re SUWALA ET AL., Application No. 10/790,946
REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

teaches nor suggests all limitations of any pending claim, all claims are believed to be allowable. Therefore, assuming the Office performed its duty as required by MPEP § 706 and 37 CFR 1.104(c)(2) and cited the best art available, then *all claims are allowable over the best prior art available*. As such, Appellants respectfully request all rejections be withdrawn, all claims be allowed, and the application be passed to issuance.